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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,261	04/02/2001	William A. Knaus	031672.0005	7290
7590	03/03/2006		EXAMINER NAJARIAN, LENA	
James Remenick POWELL GOLDSTEIN LLP 901 New York Avenue, NW Third Floor Washington, DC 20001			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 03/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/822,261	Applicant(s) KNAUS ET AL.	
	Examiner Lena Najarian	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 46-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 46-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20050826</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 8/26/05.
Claims 1-29 and 46-75 are pending. Claims 1, 46, and 65 have been amended.
Claims 30-45 have been canceled.

Double Patenting

2. The rejection of claims 1-9, 11-20, 22-29, 46-53, 55-59, 65, 70, and 73-75 is hereby withdrawn due to the terminal disclaimer filed 8/26/05.

Specification

3. The new matter objection is hereby withdrawn due to the amendment filed 8/26/05.

Claim Rejections - 35 USC § 112

4. The rejection of claims 1, 21, 46, and 65 under 35 U.S.C. 112, first paragraph, is hereby withdrawn due to the amendment filed 8/26/05.
5. Claims 1-19 and 60-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
(A) Regarding claims 1 and 65, the phrase "capable of" renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The Examiner suggests

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Applicant remove the phrases "capable of." For example, change "the medical record of a person is capable of being transmitted" to "the medical record of a person is transmitted."

(B) Claims 2-19, 60-64, and 66-75 incorporate the deficiencies of claims 1 and 65, through dependency, and are also rejected.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-11, 18-26, 29, 46-47, and 51-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363).

(A) Claims 1 and 65 have been amended to now recite "capable of being transmitted" as opposed to "transmissible" and "capable of being" as opposed to the previously recited "can be."

Claims 1, 46, and 65 have also been amended to overcome 112, 1st paragraph issues set forth in the prior Office Action. Applicant has deleted the phrases "as to transcription" and "of transcription" from the claims.

However, these changes do not affect the scope and breadth of the claims as originally presented and/or in the manner in which the claims were interpreted

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by the Examiner when applying prior art within the previous Office Action. As such, these claims are rejected under the same rationale given in the prior Office Action, and incorporated herein.

(B) Claims 2-11, 18-26, 29, 47, 51-64 and 66-75 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363), and further in view of Baker ("PCASSO: A Model for Safe Use of the Internet in Healthcare").

(A) Claim 12 has not been amended and is rejected for the same reasons given in the previous Office Action, and incorporated herein.

9. Claims 13-15, 27-28, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363), and further in view of Malik (US 2001/0037219 A1).

(A) Claims 13-15, 27-28, and 48-50 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

10. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snowden et al. (US 2002/0026332 A1) in view of Shepard (6,026,363), and further in view of Shear (4,827,508).

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(A) Claims 16-17 have not been amended and are rejected for the same reasons given in the previous Office Action, and incorporated herein.

Affidavits

11. Applicant has submitted an affidavit to remove Snowden (60/169,065) and Malik (60/200,091) as references applied under 35 U.S.C. § 102(e)/103(a) in the previous Office Action. The declaration filed on 8/26/05 under 37 C.F.R. § 1.131 has been considered but is ineffective to overcome the Snowden and Malik references for the following reasons:

(i) MPEP Section 715.02 states the following:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965).

In this case, the averred statements of William A. Knaus and Richard D. Marks and the exhibits attached thereto fail to establish either conception of and/or reduction to practice **of the whole invention claimed or something falling within the claim**. As such, it is respectfully submitted there is no clear nexus between the materials and the claimed subject matter. In particular, Applicant has not pointed out specific portions of the submitted materials directly tied to the elements or features that are being claimed. Instead, Applicant has pointed out sections he believes to be related to Snowden's invention. To the extent that the Examiner understands the submitted materials, the Brief

Background and Rationale section of the document at page 4 makes references to elements not present in any of the recited claims, namely, that the "patient would be the main repository" and "'carry' the results with them to all medical encounters". In addition, at page 3, the document makes references to a "trusted agent." The Examiner was unable to find, nor does Applicant point to, such features within the pending claims. As such, the Examiner cannot ascertain what invention was conceived and reduced to practice - the invention of the claims or some other invention?

Response to Arguments

12. Applicant's arguments filed 8/26/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 8/26/05.

(1) Applicant argues that data integrity, as disclosed in Snowden (see Snowden, paragraph 121), does not imply a characteristic of non-repudiation as claimed by applicant (see specification, page 21, lines 20-28).

(2) Applicant argues that Snowden and Malik are not prior art.

(3) Applicant argues that Shepard teaches away from Applicant's invention.

Applicant asserts that Shepard is not combinable with Snowden and would not lead one skilled in the art toward applicant's invention. The Shepard medical record management system is directed to a hospital-based system and it is not a patient-based record system as described in the instant application.

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(4) Applicant argues at pages 20-21 of the amendment that there is no vetting or certification in Shepard according to applicant's claimed invention and that the proposed combination with Snowden is not logical.

(A) As per the first argument, Applicant merely points to a passage in the specification that broadly defines non-repudiation as "provides a level of assurance to the correctness and accuracy of records." In addition, the Examiner did not merely rely on Snowden for the characteristic of non-repudiation. Rather, the Examiner relied on Shepard (see pages 6-7 of the Office Action mailed 8/1/05).

(B) As per the second argument, Applicant's affidavit is insufficient. As such, Snowden and Malik remain valid prior art.

(C) As per the third argument, in response to applicant's argument that Shepard is a hospital-based system, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(D) As per the fourth argument, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

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suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner relied upon the combination of Snowden and Shepard. Applicant recites in claim 20 that "the medical information of said at least one medical record is better than exists at a source site from which the medical record was obtained." Snowden discloses that medical information comes from various sources (see para. 47 of Snowden). The Examiner relied on Shepard for the feature of verifying the accuracy of the patient's medical information (see col. 4, line 60 – col. 5, line 11 of Shepard). Also, the Examiner has provided a motivation for combining the references. As such, the proposed combination of references is logical to one of ordinary skill in the art.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ln

11-2-05


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